

Remarks/Arguments:

Claims 1-4 and 6-23 are presently pending. All pending claims stand rejected. Reconsideration of all claim rejections is requested based on the following remarks.

Claims 1-4 and 6-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,204,496 to Boulay et al. (herein Boulay) in view of U.S. Patent No. 5,354,951 to Lange, Sr. et al. (herein Lange).

Claim 1 is directed to a computer system that includes the following features:

an electronic assembly having an enclosure, a first access opening defined by said enclosure, and a second access opening defined by said enclosure;

a device coupled to said electronic assembly via said first access opening; and

a shield coupled to said electronic assembly and positioned to cover said second access opening defined by said enclosure, wherein said shield includes a cover portion and a plurality of extensions adjacent said cover portion, said extensions together at least partially defining a channel extending along at least a portion of said cover portion, said channel having substantially parallel boundaries, said channel being configured to receive a portion of the enclosure and to slidably engage the enclosure such that, when engaged, said cover portion inhibits electromagnetic interference emissions from the enclosure.

The computer system recited in claim 1 therefore includes an electronic assembly having an enclosure, a device, and a shield. The shield includes a cover portion and a plurality of extensions adjacent the cover portion. The extensions at least partially define a channel that slidably engages the enclosure of the electronic assembly, and the cover portion inhibits electromagnetic (EMI) emissions from the enclosure when the channel engages the enclosure. Thus, the shield slidably engages the enclosure to inhibit EMI emissions from the enclosure. Exemplary embodiments of this feature are found throughout the specification of the originally filed application and, for example, at paragraph 44 and in FIGs. 3A and 4.

Applicants contend that the Office Action fails to set forth a prima facie case of obviousness. The requirements to establish a prima facie case of obviousness are set forth in MPEP § 2142, which recites:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Boulay invention is an EMI shielding gasket made of springy electrical conducting material that includes pair of spaced apart channel members comprising resilient electrical contact means and a pair spaced apart connecting portions joining the two channel members together. FIG. 6 of Boulay shows one of Boulay's gaskets 22 held in position to be mounted at a slot 20.

As indicated in Boulay, ends 26 of gasket 22 are held in a bowed condition for snap-in mounting of the gasket 22. In this bowed condition the U-shaped side channel members 24 of the gasket 22 are placed closer together for ease of mounting and the channel entrances 34 are disposed for easier mounting.

Unlike Boulay (which is directed to sealing around slots and openings to inhibit EMI emissions though such openings in enclosures containing electronic equipment), Lange sought improvements in the design of shielding devices for circuit board components that will adapt such devices for use in other applications. Lange discloses a circuit board component EMI shielding assembly 10 that includes an elongated fence or enclosure 12 and a pair of top and bottom covers 14, 16 fitted over and substantially closing open upper and lower ends 12A, 12B of the enclosure 12, the top and bottom covers 14, 16 being substantially identical in configuration to one another.

Lange's EMI shielding assembly 10 is defined by an elongated generally planar bendable strip 18 of material which is bent to define corners 20 of the enclosure 12 and a plurality of generally planar walls 22. The walls 22 are thus arranged in a polygonal, and preferably rectangular, configuration so as to adapt the enclosure 12 to surround an electronic component mounted on a substrate B, such as a circuit board, as seen in Lange's FIG. 3. Flared ends 26A, 32A and 28A, 34A of the upper and lower outer tabs 26, 32 of the walls 22 are intended to make it relatively easy to insert the respective top and bottom covers 14, 16 downwardly and upwardly to receive the top and bottom covers 14, 16.

As recognized in the Office Action, Boulay does not disclose a shield such as the shield set forth in claim 1. Rather, Lange is relied upon to disclose "an assembly wherein a shield includes a cover portion (for example, see element 18, Figs. 1-7) and a plurality of extensions adjacent the cover portion (for example, see elements 24, 26, 18, Figs. 1-7), the extensions together at least partially defining a channel extending along at least a portion of the cover portion (for example, see element 30, Figs. 1-7), the channel having substantially parallel boundaries, the channel being configured to receive a portion of the enclosure such that, when engaged, the cover portion inhibits electromagnetic interference emissions from the enclosure (for example, see Figs 1-7)."

It is respectfully submitted that Lange fails to disclose, teach, or suggest a shield that includes a cover portion and a plurality of extensions adjacent the cover portion, the extensions together at least partially defining a channel that is configured to receive a portion of the enclosure as set forth in claim 1. The Office Action points to element 18 of Lange as disclosing the cover portion of claim 1 and elements 24 and 26 of Lange as the extensions of claim 1 extending along the cover portion. Element 18 of Lange is a polygonal wall for surrounding an electronic component, and elements 24 and 26 are tabs formed on the wall that receive a cover 14. See Lange at column 3, lines 30-34 and column 3, line 62 through column 4, line 5. Thus, the element in Lange identified in the Office Action as the cover portion (i.e., element 18) receives another cover (i.e., element 14 of Lange) rather than an enclosure to inhibit EMI emissions from the enclosure. As element 14 of Lange is simply a cover (see FIG. 3 of Lange), there is no EMI emissions to be inhibited therefrom. Accordingly, Lange fails to disclose, teach, or suggest a shield as set forth in claim 1.

Additionally, it is notable that claim 1 recites the "said channel [is] configured ... to *slidably* engage the enclosure." Referring to the Applicant's specification for purposes of illustration, an exemplary shield 106 inhibits electromagnetic interference emanations from an enclosure 200 and includes a cover portion 302 and a plurality of extensions 304 adjacent the cover portion 302, the extensions 304 together at least partially defining a channel 306 extending along at least a portion of the cover portion 302, the channel 306 having substantially parallel boundaries. The channel 306 is configured to received a portion 206 of the enclosure 200 and to *slidably* engage the enclosure 200 such that, when engaged, the cover portion 302 inhibits electromagnetic interference emanation.

The Office Action fails to acknowledge this element of claim 1 in any way and also fails to cite to any disclosure of Boulay or Lange that shows or suggests such slidable engagement. Absent disclosure of a channel configured to *slidably* engage the enclosure, *prima facie* obviousness is not established.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Since neither Lange nor Boulay discloses a shield such as the shield set forth in claim 1, Lange and Boulay, neither alone nor in combination proposed in the Office Action, teach each and every limitation of claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for at least this reason.

Additionally, Applicants respectfully submit that there is no suggestion or motivation to combine the Boulay and Lange references.

Boulay is directed to an electromagnetic interference (EMI) shielding gasket. In Boulay, the EMI shielding gasket is snapped into openings within an enclosure such as a computer housing to contain EMI emissions. The EMI shielding gasket is made of a springy electrical conducting materials that includes a pair of spaced apart channels. The EMI shielding gasket is compressed to move the spaced apart channels closer together during insertion into an opening within an enclosure and then released to allow the spaced apart channels to engage the edge of the opening, thereby mounting the EMI shielding gasket within the opening. The EMI shielding gasket allows more closely spaced expansion slots, including standard slots, and does so while providing good electrical contact with circuit cards, slot covers, and the like to effect EMI shielding. See Boulay at column 2, lines 33-37. The EMI shielding provided in Boulay is for EMI containment. See Boulay at column 1, lines 8-17.

Lange is directed to a circuit board component shielding enclosure and assembly. The circuit board component shielding enclosure and assembly surrounds an electronic component on a circuit board when it is attached to the circuit board. The circuit board

component shielding enclosure and assembly shields the circuit board component against EMI by clipping top and bottom covers 14, 16 to walls of an enclosure. See Lange at column 1, lines 9-12. Such shields are generally grounded to allow electrical charges and fields to be dissipated without disrupting the operation of the electronic components enclosed within the shield. See Lange at column 1, lines 21-24. Thus, the shield in Lange is designed to protect the component surrounded by the shield from EMI.

The Office Action recites that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a cover portion with extensions defining a channel as taught by Lange, Sr. et al in the Assembly as taught by Boulay for the purpose of providing an effective and removable electromagnetic shielding enclosure." Applicants respectfully disagree.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350.

Boulay and Lange solve different problems. Boulay is directed to an EMI shielding gasket that contains the emission of EMI from an opening in an enclosure. See Boulay at column 1, lines 5-17. Lange, on the other hand, is directed to a shield that surrounds an electronic component on a circuit board to shield the component against external EMI. See Lange at column 1, lines 7-12. Thus, Boulay solves the problem of inhibiting EMI from escaping through opening in an enclosure and Lange solves the problem of shielding components on a circuit board. Since Boulay and Lange solve different problems, the nature of the problem solved by the references does not serve as a motivation to combine references.

In addition, Boulay and Lange teach divergent solutions to their respective problems. Boulay teaches an EMI shielding gasket made of springy electrical conducting material that includes pair of spaced apart channel members, wherein ends 26 of a gasket 22 are held in a bowed condition for snap-in mounting of the gasket 22. In contrast to Boulay, Lange teaches a circuit board component EMI shielding assembly 10 that includes an enclosure 12 and a pair of top and bottom covers 14, 16 fitted over and substantially closing open upper

and lower ends 12A, 12B of the enclosure 12 so as to adapt the enclosure 12 to surround an electronic component mounted on a circuit board. Since Boulay and Lange teach solutions to different problems, the teachings of these references does not serve as a motivation to combine references.

Further, the Office Action fails to point out any motivation for one skilled in the art to combine aspects of a shield meant for surrounding an electronic component on a printed circuit board to shield the electronic component against EMI (as in Lange) with a shield meant to inhibit EMI from an opening from within an enclosure (as in Boulay). Thus, persons of ordinary skill in the art would not be motivated to combine Boulay and Lange in a manner to arrive at the invention recited in claim 1. The only motivation to arrive at Applicants' claimed invention is found in Applicants' specification, and the use of such hindsight reconstruction and the picking and choosing of disparate teachings from prior art references is impermissible hindsight reconstruction.

For at least the foregoing reasons, it would not be obvious to combine Lange and Boulay as proposed in the Office Action. Accordingly, Applicants respectfully submit that a prima facie case of obviousness has not been established for at least this additional reason.

Accordingly, for the reasons set forth above, Applicants respectfully submit that a prima facie case of obviousness has not been established. Therefore, Applicants contend that claim 1 is allowable over the applied references and respectfully request that the rejection of claim 1 be withdrawn.

Claim 12, while not identical to claim 1, includes features similar to claim 1. Accordingly, Applicants contend that claim 12 is also allowable over the applied references for the reasons set forth above with respect to claim 1 and respectfully request that the rejection of claim 12 be withdrawn.

Claim 19 was rejected on the same grounds as claim 1. Accordingly, Applicants contend that claim 19 is also allowable over the cited art for at least the reason that a prima facie case of obviousness for combining Boulay and Lange has not been established as set forth above with respect to claim 1. Therefore, Applicants respectfully request that the rejection of claim 19 be withdrawn.

Claims 2, 4, 6-11, 13-18, and 20 include all of the features of one of independent claims 1, 12, and 19 from which they ultimately depend. Thus, claims 2, 4, 6-11, 13-18, and 20 are also allowable over the cited art for at least the reasons set forth with respect to the independent claim from which they ultimately depend. Accordingly, Applicants contend that claims 2, 4, 6-11, 13-18, and 20 are likewise allowable and, therefore, respectfully request that the rejection of claims 2, 4, 6-11, 13-18, and 20 be withdrawn for at least this reason.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Boulay in view of Lange and further in view of U.S. Statutory Invention Registration H526 to Miller (herein Miller). Applicants respectfully request reconsideration.

Claim 3 depends directly from claim 1 and includes all of the features and limitations of claim 1. The feature that was found to be lacking in Boulay and Lange with reference to claim 1 is not found in Miller; namely, a shield including a cover portion and a plurality of extension adjacent the cover portion where the extensions define a channel that slidably engages an enclosure to inhibit EMI emissions from the enclosure. Thus, Miller fails to make up for the deficiencies of Boulay and Lange. Additionally, as with claim 1, Applicants contend that a *prima facie* case of obviousness has not been established in combining Boulay and Lange and, thus, the proposed combination is improper. Accordingly, Applicants contend that claim 3 is allowable and, therefore, respectfully request withdrawal of the rejection of claim 3.

Appln. No.: 10/727,757
Amendment Dated December 5, 2005
Reply to Office Action of October 5, 2005

TN324 (UNS-457US)

In view of the remarks set forth above, Applicants respectfully submit that claims 1-4 and 6-23 are in condition for allowance and early notification to that effect is earnestly solicited.

Respectfully submitted,

RatnerPrestia



Joshua L. Cohen, Reg. No. 38,040
Stephen J. Weed, Reg. No. 45,202
Attorneys for Applicants

SJW/kpc

Dated: December 5, 2005

P. O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **18-0350** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 5, 2005.



Kathleen P. Carney